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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,283	11/14/2003	Eric Garland	7330.P001	2048
8791 7590 06/21/2007 BLAKELY SOKOLOFF TAYLOR & ZAFMAN 1279 OAKMEAD PARKWAY SUNNYVALE, CA 94085-4040			EXAMINER ROBINSON, GRETA LEE	
			ART UNIT 2168	PAPER NUMBER
			MAIL DATE 06/21/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/714,283	Applicant(s) GARLAND ET AL.	
	Examiner Greta L. Robinson	Art Unit 2168	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-16, 24-30 and 39-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration:
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-16, 24-30 and 39-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on April 12, 2007 has been entered.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 9-16 and 24-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As presently written the claims are directed to an abstract idea and do not include a concrete, useful tangible result. The preamble of the claims state limitation for *tracking file storage* on a file-sharing or peer-to-peer network [see independent claims 9 and 24]; however the body of the claim *omits* limitation that file storage is being tracked. The body of independent claim 9 recites "a database to track files available", however does not state anything about the storage. Also, the claim does not appear to do anything with the database to track files available (i.e. the claim does not recite a specific function is being performed). The body of

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independent claim 24 omits limitation directed to tracking or tracking file storage;
therefor the claim does not recite a tangible result for each cited structure.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 9-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation "passively transferring" [see claim 9 line 10], does not appear to be described in the disclosure.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 9-16 and 24-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 9 recites the limitation "the network" in line 3. There is insufficient antecedent basis for this limitation in the claim. Also note independent claim 24 line 5. Claims 10-16 and 25-30 are rejected based on dependency.

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claim 24-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Dutta et al. US Patent Application Publication No. 2002/0138471 A1. (Note limitation with respect to "passively transferring" as deleted from claim 24 therefor Nair et al. reference not applied.)

As per independent claim 24 Dutta teaches:

coupling a computer to a database, the database to store lists of shared files available from peer computers on the file-sharing or peer-to-peer network at fig.4, paragraph 70 and 0066;

coupling the computer to the network at fig.4, paragraph 70 (client rating database); locating a plurality of computers connected to the network by IP address at paragraph 71, lines 4-5;

requesting a listing of a library of shared files from each of said plurality of computers connected to the network at paragraph 59, lines 1-4;

receiving the listing of the plurality of libraries of shared files from the computer to the database ... at paragraph 60, lines 1-4 and paragraph 0041.

As per claim 25, same as claim arguments above and Dutta teaches:

further comprising adding source information to each of the listings at paragraph 71. As

As per claim 26, same as claim arguments above and Dutta teaches:

wherein the source information comprises the geographic location of a computer

where the library is stored at paragraph 71.

10. Claim 39-43 are rejected under 35 U.S.C. 102(e) as being anticipated by O'Kane US Patent Application Publication No. 2003/0105831 A1.

Regarding claim 39, O'Kane teaches a method of reporting on shared files available through a peer-to-peer network comprising [abstract; paragraph 0001]:

obtaining a plurality of inventories of shared files, one inventory from each of a plurality of nodes in a peer-to-peer network [note: paragraph 0042];

storing the plurality of inventories in a database [note: paragraph 0043 storage system 24]; and

generating a report based on the inventories in the database ... [note: paragraphs 0062 through 0067].

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Regarding claims 40-43, "wherein the inventories are inventories of MP3 files" ... "shared files" "wherein the report shows a percentage" [note: paragraph 0019-0023].

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al. US Patent Application Publication No. 2002/0138471 A1 in view of Nair.

As per independent claim 9 Dutta teaches:

a computer coupled to the network at fig.4, paragraph 70;

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a database to track files available on the file-sharing or peer-to-peer network coupled to the computer at fig.4, paragraph 0066 ratings module monitors events also see paragraph 70 (client rating database);

a query device adapted to request a list of shared files from a plurality of computers connected to the network at paragraph 59, lines 1-4;

and a transfer device adapted to receive the a list of shared files from each computer of the plurality of computers and store the list of shared files by passively transferring the list of shared files from each computer of the plurality of computers and automatically store the list of shared files in the database see paragraph 60, lines 1-4, also note *shared file list* 264 paragraph 0041.

Dutta does not explicitly teach transferring passively; however Dutta et al. does teach passively tracking peer-to-peer actions [note: paragraph 0066]. Nair teaches this feature [see: paragraph 9]. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to make it simple to find and exchange files (parg. 9, lines 16-17). Also because Nair teaches the peer-to-peer network provides for anonymous transfer of files.

With respect to claim 10, same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database at paragraph 71(client ratings database) and parg. 77, lines 11-13, rating server.

As per claim 11, same as claim arguments above and Dutta teaches:

further comprising an archiving system coupled to the database, the archiving system to store at least one copy of the plurality of lists at paragraph 71(client ratings database).

As per claim 12, same as claim arguments above and Dutta teaches:

further comprising an inventory processing server coupled to the database at paragraph 71.

13. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) and Nair (US 2004/0193900) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 13-14 same as claim arguments above and Dutta teaches: further comprising an inventory preparation server coupled to the database, an inventory processing server coupled to the inventory preparation server at fig.4. Dutta and Nair do not explicitly teach a report preparation server coupled to the inventory processing server however O'Kane teaches this limitation at paragraph 62, lines 1-6 and paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

14. Claims 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dutta et al (Pub. No.: US 2002/0138471) in view of O'Kane (Pub. No.: US 2003/0105831).

As per claim 29-30 same as claim arguments above, however Dutta do not explicitly teach generating at least one report including data from a plurality of listings and a plurality of search requests however O'Kane teaches this limitation at paragraph 62, lines 1-6 and

paragraph 63. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the cited references to allow intellectual property owners a means to track royalties at paragraph 19, lines 1-4.

Response to Arguments

15. Applicant's arguments filed April 12, 2006 have been fully considered but they are not persuasive.

In the response Applicant argued the claims have been amended to overcome the rejections. Specifically claims 9 and 24 have been amended to specify the database is to store lists of shared files available from peer computers on a peer-to-peer network and that the claimed system or method receives the list of shared files. In response to applicants amendment note newly cited rejections under 35 USC 101 and 35 USC 112 first and second paragraphs above. The examiner respectfully maintains the rejection. Note Dutta teaches an alternative (264) list of shared files which may be imported and exported see paragraph 0041 and Figure 2C sharable file list element 264. O'Kane teaches devices in a file sharing environment for tracking and regulating process see paragraph 0062-0063.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Aboulhosn et al. US Patent 6,983,042 B2


De Meno et al. US Patent 6,721,767 B2

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17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greta L. Robinson whose telephone number is (571)272-4118. The examiner can normally be reached on M-F 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tim T. Vo can be reached on (571)272-3642. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



GRETA ROBINSON
PRIMARY EXAMINER

Greta Robinson
Primary Examiner
June 15, 2007